

REMARKS/ARGUMENTS

Pages 1 and 2 of the specification have been amended to update the list of co-pending applications with USPTO application serial numbers.

Claims

The Examiner rejected claims 1-3, 8-28 and 34-114 and objected to claims 1-3, 8-29 and 34-45. Claims 4-7 and 30-33 have been withdrawn from consideration. By this amendment, claims 1, 27, 46, 66, 79 and 101 have been amended. Therefore claims 1-114 remain pending in the application.

Claim Objections

Claims 1-3, 8-29 and 34-45 were objected to because the Examiner stated that the “form including printed coded data indicative of an identity of the form and of at least one location on the form” is not descriptive. The Examiner stated that the coded data should be further defined in the claim to clarify the preamble.

The Applicant has therefore amended independent claims 1 and 27 to change the term “printed coded data” to “printed coded data, configured as tags.” That should completely clarify the meaning of the preamble of claims 1 and 27. The term “tags” is defined in great detail in the specification concerning one particular embodiment of the present invention, and its meaning is very clear. For example, page 16 of the specification as originally filed, at lines 21-24, states: *“Each reference to the page description is encoded in a printed tag. The tag identifies the unique page on which it appears, and thereby indirectly identifies the page description. The tag also identifies its own position on the page. Characteristics of the tags are described in more detail below.”* See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) (“Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation.’”) 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original).

Thus the Applicants believe that the meaning of the preamble of claims 1 and 27 is very clear. If the Examiner still disagrees, the Applicants hope to resolve this issue in a telephone interview with the Examiner that the Applicants will attempt to schedule shortly.

Claim Rejections – 35 USC §103

Claims 1-3, 8-18, 22-25, 27-29, 34-41, 43, 44, 46-57, 61-64, 66-74, 76, 77, 79-92, 96-99, 101-110, 112 and 113 were rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (U.S. Pat. No. 5,799,157) in view of Suda et al. (U.S. Pat. No. 6,157,465). The rejection is respectfully traversed.

The Examiner asserted that Escallon discloses a form including data indicative of the identity of the form and a position of a sensing device relative to the form. The Examiner reasoned that “the ‘position’ of a sensing device is known therefore the sensing of the coded data can take place.” The Examiner further asserted that the sensing device client computer 100 of Escallon may obviously be substituted with the hand-held sensing device of Suda to arrive at the presently claimed invention.

The above logic, although perhaps appearing reasonable on its face, actually requires an act of leger demain that makes the logic unsupportable. The “position” of the sensing device of Escallon is known relative to the electronic forms 140 of Escallon only when the sensing device is a client computer 100 on which the forms 140 may be displayed and processed. As soon as one substitutes—as suggested by the Examiner—the client computer 100 of Escallon with the hand-held sensing device of Suda (the “e-pen marking device”), there is no way to identify a position of the sensing device relative to the form because, indeed, there is no longer a computer 100 on which the forms may be rendered. Further, if one simply adds the e-pen marking device of Suda to the computer 100 of Escallon, then there is still no way to identify the position of the marking device relative to the electronic forms 140 because the electronic forms 140 include no position data that is readable by the marking device. See MPEP 2141.02: “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).”

Nevertheless, to further the prosecution of this application, the Applicants have hereby amended all independent claims in the application by adding the limitation that the forms of the present invention are paper forms. That should further help overcome the rejections involving Escallon, as the portions of Escallon cited by the Examiner disclose the use of only electronic forms 140.

Next, in response to the Applicants’ argument that Suda’s pen (in connection with Suda’s controller 605) is very different from the sensing device of the present invention, the Examiner asserted that “Suda’s pen performs the functions of Escallon’s communication link 110 in addition to its regular functions.” However the Examiner’s assertion is now moot in light of the present amendments that limit the present claims to the use of paper forms. The communication link 110 of Escallon would serve no purpose in connection with paper forms.

Finally, the Examiner equated the print media 39 of Wilz with the printed forms of the present claims. However, as argued previously, the print media 39 of Wilz include “URL-encoded truncated symbols 8” that are not analogous to the coded data indicative of a location on a form as defined in the present claims. Thus combining the paper forms of Wilz with the system of Escallon involving electronic forms, and further with the e-pen of Suda, still does not result in the present invention as defined by the presently amended claims.

Request for Telephone Interview

To further prosecution of the present application, which has now been pending for over four years, the Applicants hereby request a telephone interview with the Examiner. In light of the present amendments to the claims, if the Examiner still disagrees that the claims are allowable in view of the cited prior art, the Applicants hope to arrive at a better understanding of the reasoning of the Examiner through a telephone interview. The Applicants will telephone the Examiner shortly to arrange a mutually convenient time to discuss the present application.

Conclusion

The Applicants have amended the claims to further clarify the novel and non-obvious distinctions between the claimed invention and the cited prior art. Also, the

Applicants have demonstrated that the cited prior art is not properly combinable to reach the invention of the presently amended claims. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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